

Patent US 200C1  
Attorney Docket: 032,290-006  
(formerly ARTM 1000-5 US)

### REMARKS

Applicants thank the Examiner for taking time on November 21, 2003, to discuss the outstanding Office Action and the Supplemental Amendment and Response filed on October 29, 2003. Reconsideration of the rejections set forth in the Office Action dated November 19, 2003, is respectfully requested. Claims 1-160 are canceled. Claim 161 has been amended to recite "a swellable bioresorbable body" and to correct antecedent basis, and claims 168-170 has been newly added. Claims 161-170 are currently pending. Support for the amendments can be found in the specification at, e.g., page 2, line 33 - page 3, line 1; page 5, lines 4-10; page 6, lines 25-page 7, line 15; and page 8, line 26 - page 9, line 3. These amendments are made without introducing new matter.

### Art Rejections

Claims 89, 90, 94-100, 103, and 144-147 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Corbitt, Jr. et al. Without conceding the propriety of the rejections, Applicants have canceled claims 89, 90, 94-100, 103, and 144-147. Therefore, these rejections are now moot.

Claim 101 has been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cobitt, Jr. et al. Without conceding the propriety of the rejection, Applicants have canceled claim 101. Therefore, this rejection is now moot.

Claims 118-122, 125-131, 134-139, 143, 148, 150, and 152-167 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Corbitt, Jr. et al. in view of Foerster et al. ('055). Without conceding the propriety of the rejections, Applicants have canceled claims 118-122,

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125-131, 134-139, 143, 148, 150, and 152-160. Therefore, the rejections to these claims are now moot. As discussed with Examiner Szmal on November 21, 2003, Corbitt is not prior art to claim 161 and claims dependent thereon. With regard to Foerster, Applicants have amended independent claim 161 to require the steps of "*providing a swellable bioresorbable body*" and "*inserting the bioresorbable body into the biopsy site to mark the location of the biopsy site, wherein the bioresorbable body swells upon contact with body fluid*." Specification support for all of the currently pending claims can be found in U.S. Application Serial No. 60/090,243, filed June 22, 1998, the benefit of which is claimed in the present application. Support can be found at, e.g., page 7, lines 3-10 and page 10, lines 18-22 of this provisional application. In addition, Foerster ('055) does not teach or suggest a swellable bioresorbably body that swells upon contact with body fluid. Therefore, Applicants respectfully request withdrawal of the rejection and reconsideration of the claims as amended.

Claims 123, 124, 132, 133, 141, and 142 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Corbitt, Jr. et al. and Foerster et al. ('055) as applied to claims 118, 127, and 136 above, and further in view of Unger et al. Without conceding the propriety of the rejection, Applicants have canceled claims 123, 124, 132, 133, 141, and 142. Therefore, these rejections are now moot.

### CONCLUSION

For all the foregoing reasons, Applicants respectfully assert the pending claims are now in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any minor issues remain, please contact Applicants' undersigned representative at

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(949) 737-2900. The Commissioner is hereby authorized to charge any fees that may be required to  
Deposit Account No. 50-2862.

Respectfully submitted,

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